



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,888	12/05/2001	Ronald Huner	584.12-US1	5270

34284 7590 07/26/2004

ROBERT D. FISH; RUTAN & TUCKER, LLP
P.O. BOX 1950
611 ANTON BLVD., 14TH FLOOR
COSTA MESA, CA 92628-1950

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,888

Applicant(s)

HUNER, RONALD

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-55 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17-55 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 53-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the new limitation added to claim 53: wherein the sulfide is coated prior to addition of a selected metal powder. This is deemed to be a prima facie showing that the specification fails to describe the claimed invention. The burden is now on applicant to demonstrate that the specification complies with the written description requirement.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if claim 53 requires that a selected metal powder must be added.
And if so, it is unclear if it must be added to the powder.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 55 is rejected under 35 U.S.C. 102(b) as being anticipated by Uenosono 5938814.

See how Uenosono was previously applied.

Claims 17-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Storstrom 5480469.

See how Storstrom was previously applied. As to amended claim 53, such can be met in two ways. First, it is met in that the manganese is coated prior to addition of uranium powder. The claim does not require the addition of uranium as a selected powder, so Storstrom does not need to teach the addition of uranium. The claim is comprising in nature and is open to having other metal powders mixed with the manganese sulfide prior to addition of a "selected" metal powder.

Alternatively, by looking at the Storstrom powder, one cannot tell when it is coated. It can be coated before or after the addition of another metal powder.

The courts have been holding for quite some time that “—in spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps.” (In re Hughes, 182 USPQ). Also, “—patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.” (In re Pilkington, 162 USPQ 147).

Therefore in the present claim, it does not matter when the coating takes place – there must be a difference in the product. The timing of coating does not result in a difference in the final powder.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chopra 5768678 in view of Grady 6287513.

See how this combination was applied in the prior Office actions. And how the amendment to claim 53 does not substantially limit the claim so as to define over the prior art as indicated above.

Response to Arguments

Applicant's arguments filed 6/15/04 have been fully considered but they are not persuasive.

It is argued that Uenosono is completely silent as to the use of surface modified manganese sulfide. This does not appear to be relevant (even if it is true). Claim 55 is a product claim – not a process. There is no requirement that any coating remains in the final product.

The courts have been holding for quite some time that “—in spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps.” (In re Hughes, 182 USPQ). Also, “—patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.” (In re Pilkington, 162 USPQ 147).

The process of Applicant's product-by-process claim is largely immaterial – it is only the final product that is relevant.

It is also argued that Storstrom's teaching is entirely different from Applicant's invention. This appears to be true regarding the specific embodiments – however the claims are much broader than the specific embodiments disclosed by Applicant.

It is also argued that Storstrom's coating cannot be equated with Applicant's directed coating. This does appear relevant because the claims do not require “directed bonding” therefore Storstrom need not teach such. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also,

Examiner could not see any limitation which would exclude Storstrom. Applicant has not pointed to any specific claim limitation that defines over Storstrom.

The further argument regarding binders and oxidation protection does not appear to be very important because such is also not required by the claims.

It is still further argued that Chopra and Grady cannot be combined. Examiner does not understand how this conclusion was reached. It is not stated if Applicant deems to be of non-analogous art, that the combination would not work, or what. The rejection appears to be appropriate, and therefore the rejection will stand.

It is argued that Chopra and Grady are silent as to the coating of MnS for protection against moisture, oxidation and agglomeration. This is not relevant because the claims are not limited to such a particular result.

As to the function of a coating being different from the function of a binder. The relevance is not understood. Clearly a material can function as both a binder and coating at the same time – as is done in the prior art.

AS to claim 53 it is argued that the coating must be applied before the use of MnS as an additive. The claim does not require this. The claim at most refers to adding a metal powder to the MnS – it says nothing about adding MnS to another powder. More importantly, the claim is directed to the product, not the process. When looking at the obvious Chopra-Grady powder, it would be impossible to tell whether or not the powder is coated prior to addition of a selected metal powder. Furthermore, there is no indication that the “is coated” limitation refers to the coating agent of claim 17. Ostensibly, it can be another coating that is completely removed prior to addition of

a selected metal powder. When looking at a powder, one cannot tell if a coating had been previously applied and removed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

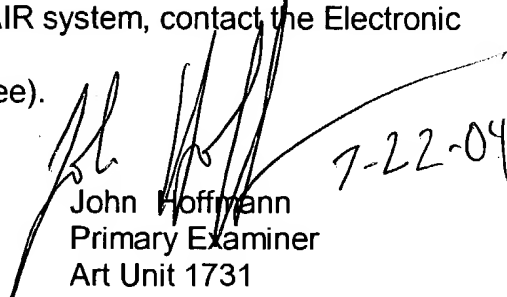
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Hoffmann
Primary Examiner
Art Unit 1731

7-22-04

jmh